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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,833	03/11/2002	Andre Belmont	112183	2520

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Oliff & Berridge
PO Box 19928
Alexandria, VA 22320

EXAMINER

KOBERT, RUSSELL MARC

ART UNIT PAPER NUMBER

2829

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

in

Office Action Summary	Application No. 10/070,833	Applicant(s) BELMONT ET AL.	
	Examiner Russell M Kobert	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election with traverse of Invention I, claims 1-5, in the Election filed October 27, 2003 is acknowledged. The traversal is on the ground(s) that the subject matter of all claims is sufficiently related that a through search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims and that the search and examination of the entire application could be made without serious burden. This is not found persuasive because Applicants have not shown that the groups are not patentably distinct. Admission on the record by Applicants that the groups are not patentably distinct will result in rejoinder. With regard to the "no burden" argument, it is noted that each distinct invention beyond one is a burden in that it draws the attention of the Examiner to its own requirements. Examination requires focus to follow search leads and patterns of logic in formulating applications of the prior art to that which is claimed. When the Examiner has to pursue several search patterns of logic simultaneously or serially, added burden is presented. In order to examine several inventions and/or species simultaneously or serially, added effort beyond that necessary for one invention or species must be expended. Where the effort is serial and the jobs are different the added burden is obvious. Digging two equal holes of the same size requires twice the effort of digging one hole. Such is an obvious conclusion. It can be argued that some inventions or species can be examined simultaneously but such is true only if they are not patentably distinct, that is, if that which applies to any one applies to all others. Where inventions or species are patentably distinct each requires separate consideration. As a for instance, consider a properly restrictable apparatus and method of use of that apparatus where one has

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details without correspondence in the other. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other constitutes a burden. If the apparatus and method of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. As a second for instance, consider a properly restrictable combination and subcombination where all the details of the subcombination are not necessary for the combination. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other is a burden. If the combination and subcombination of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. Admission on the record that the groups are not patentably distinct will result in rejoinder.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 6-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Election filed October 27, 2003.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear if the claimed invention includes the

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limitation of testing semiconductor chips having connection pads in the form of microspheres. If indeed this were the case, then furthermore it would not make clear what the invention is drawn to; a method of making or a product to be tested. Moreover, the intended use of the method of making is not considered to further limit or narrow the meets and bounds of the claimed invention. For purposes of examination, it is assumed that Applicants' claimed invention is limited to a method of making and not a product to be tested or any combination thereof. Therefore, Applicants' intended use "for testing semiconductor chips having connection pads in the form of microspheres" has not been given patentable weight. Additionally, Claim 1 recites the limitation "the active conducting area" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Belmont et al (PCT Publication No. WO 98/45716).

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6. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Belmont et al (6289583).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Amouroux et al (3716428), Fujii et al (6591491) and Matsui et al (6662442) describe methods of manufacture of circuit card substrates using photolithographic techniques.

8. A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (703) 308-5222. *Starting January 12, 2004, the new telephone number will be (571) 272-1963.* The Examiner's Supervisor, Kammie Cuneo, can be reached at (703) 308-1233. *Starting January 12, 2004, the new telephone number will be (571) 272-1957.* For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
January 7, 2004

